



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*Am*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,090	02/15/2002	Giovanni M. Agnoli	1968.0040000	8666

7590 05/17/2005

William S. Frommer  
Frommer Lawrence & Haug LLP  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
----------

MARTIN, NICHOLAS A

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/076,090

Applicant(s)

AGNOLI ET AL.

Examiner

Nicholas Martin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 2/15/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/15/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/11/03-1/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 1-38 are presented for examination.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10 and 24-33, drawn to cache access of requested transcoded media content, classified in class 709, subclass 203.
  - II. Claims 11-23, drawn to on-demand transcoding to produce requested media content, classified in class 709, subclass 246.
  - III. Claims 34-35, drawn to determination of optimum publishing option, classified in class 700, subclass 28.
  - IV. Claim 36, drawn to speculative predictions of publishing request, classified in class 712, subclass 233.
  - V. Claim 37, drawn to ascertaining availability of a server and the list of services it is configured to perform, classified in class 714, subclass 1.
  - VI. Claim 38, drawn to shutting down a server transparent to a client, classified in class 713, subclass 324.

3. The inventions are distinct, each from each other because of the following reasons:

Inventions I-IV are related as subcombinations disclosed as usable together in a combination of Inventions I and II, I and III, I and IV, II and III, II and IV, III and IV. The subcombinations are distinct from each other if they are shown to be separately usable.

Art Unit: 2154

In the instant case, invention I has separate utility such as cache access of requested transcoded media content lacking on-demand transcoding to produce requested media content, determination of optimum publishing option and speculative predictions of publishing request. Invention II has separate utility such as on-demand transcoding to produce requested media content lacking cache access of requested transcoded media content, determination of optimum publishing option and speculative predictions of publishing request. Invention III has separate utility such as determination of optimum publishing option lacking cache access of requested transcoded media content, on-demand transcoding to produce requested media content and speculative predictions of publishing request. Invention IV has separate utility such as speculative predictions of publishing request lacking cache access of requested transcoded media content, on-demand transcoding to produce requested media content and determination of optimum publishing option. See MPEP § 806.05(d). Also the restriction requirement is based on the interpretation that every dependent claim is dependent on the preceding independent claim (note Applicant's claim numbering).

Inventions V-VI are related as subcombinations, are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as ascertaining availability of a server and the list of services it is configured to perform lacking shutting down a server transparent to a client. See MPEP § 806.05(d).

Inventions I-IV and V-VI are related, as combinations are distinct from each other if they are shown to be separately usable. Inventions I-IV have separate utility such as publishing media content lacking ascertaining availability of a server and the list of services it is configured to perform and shutting down a server transparent to a client. See MPEP § 806.05(c).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VI, the search required for Group II is not required for Groups III-VI, the search required for Group III is not required for Group IV-VI, the search required for Group IV is not required for Group V-VI and the search required for Group V is not required for Group VI.

6. A telephone call was made to William Frommer ((212) 588-0800) on May 5, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Art Unit: 2154

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Conclusion***

8. A shortened statutory period for reply to this Office action is set to expire in ONE MONTH from the mailing date of this action.

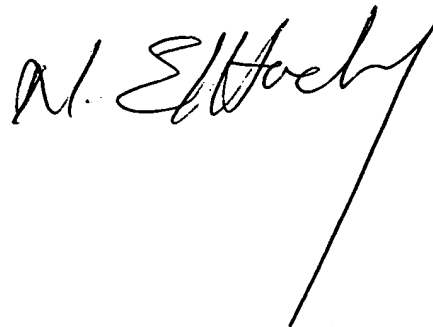
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Martin whose telephone number is (571) 272-3970. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3970.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Martin  
May 5, 2005

A handwritten signature in black ink, appearing to read "N. El-Hachy", with a long diagonal stroke extending downwards and to the right.